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VIA HAND DELIVERY JULY 26, 2002



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of: Ruben et al.

Docket No. PZ013P1C1

Application No.: 09/774,639

Group Art Unit: 1634

Filed: February 1, 2001

Examiner: Carla J. Moyer

For: **Secreted Protein HBJFE12**
(as amended herein)

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PROVISIONAL ELECTION UNDER 37 C.F.R. § 1.143
WITH TRAVERSE AND AMENDMENT UNDER 37 C.F.R. § 1.111

Commissioner For Patents
Washington, D.C. 20231

Dear Sir:

In response to the Restriction Requirement mailed June 26, 2002, Applicants provisionally elect, *with traverse*, Group II, encompassing claims 11, 12 and 16 and by newly added claims 25 to 77, drawn to polypeptides corresponding to SEQ ID NO:139 and clone ID HBJFE12, for further prosecution. Applicants reserve the right to file one or more divisional applications directed to the non-elected inventions should the restriction requirement be made final. Applicants submit concurrently herewith: (a) a Fee Transmittal sheet, with appropriate fee; (b) Version With Markings to Show Changes Made; (c) an Information Disclosure Statement Pursuant to 37 C.F.R. § 1.56 with Form PTO/SB/08; and (d) copies of references AA-AL.

Prior to substantive examination, please amend the application as follows.

In the Title:

Please delete the existing title and replace therefore -- **Secreted Protein HBJFE12** --.

In the Claims:

Please cancel claims 2-10, 12, 14-16, and 21 without prejudice or disclaimer.

Please enter the following new claims 25 to 77:

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01 FEE102

702.00 CH
756.00 CH

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-- 25. (New) An isolated polypeptide comprising amino acid residues 19 to 47 of SEQ ID NO:139.

26. (New) The isolated polypeptide of claim 25 which comprises amino acid residues 2 to 47 of SEQ ID NO:139.

27. (New) The isolated polypeptide of claim 25 which comprises amino acid residues 1 to 47 of SEQ ID NO:139.

28. (New) The isolated polypeptide of claim 25 which further comprises a polypeptide sequence heterologous to SEQ ID NO:139.

29. (New) A composition comprising the isolated polypeptide of claim 25 and an acceptable carrier.

30. (New) An isolated protein produced by the method comprising:

- (a) expressing the polypeptide of claim 25 by a cell; and
- (b) recovering said protein.

31. (New) An isolated protein comprising the amino acid sequence of the secreted portion of the polypeptide encoded by the HBJFE12 cDNA contained in ATCC Deposit No. 209177.

32. (New) The isolated protein of claim 31 which comprises the amino acid sequence of the complete polypeptide encoded by the HBJFE12 cDNA contained in ATCC Deposit No. 209177, excepting the N-terminal methionine.

33. (New) The isolated protein of claim 31 which comprises the amino acid sequence of the complete polypeptide encoded by the HBJFE12 cDNA contained in ATCC Deposit No. 209177.

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34. (New) The protein of claim 31 which further comprises a polypeptide sequence heterologous to SEQ ID NO:139.

35. (New) A composition comprising the protein of claim 31 and an acceptable carrier.

36. (New) An isolated protein produced by the method comprising:
(a) expressing the protein of claim 31 by a cell; and
(b) recovering said protein.

37. (New) An isolated first polypeptide at least 90% identical to a second polypeptide consisting of amino acid residues 19 to 47 of SEQ ID NO:139, wherein said first polypeptide is capable of being used to generate or select an antibody that specifically binds the second polypeptide.

38. (New) The isolated first polypeptide of claim 37, wherein said first polypeptide is at least 95% identical to said second polypeptide.

39. (New) The isolated first polypeptide of claim 37 which further comprises a polypeptide sequence heterologous to SEQ ID NO:139.

40. (New) A composition comprising the isolated first polypeptide of claim 37 and an acceptable carrier.

41. (New) An isolated protein produced by the method comprising:
(a) expressing the first polypeptide of claim 37 by a cell; and
(b) recovering said protein.

42. (New) An isolated first polypeptide at least 90% identical to a second polypeptide consisting of the secreted portion of the polypeptide encoded by the HBJFE12 cDNA contained in ATCC Deposit No. 209177, wherein said first polypeptide is capable of being used to generate or select an antibody that specifically binds the second polypeptide.

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43. (New) The isolated first polypeptide of claim 42, wherein said first polypeptide is at least 95% identical to the said second polypeptide.

44. (New) The isolated first polypeptide of claim 42 which further comprises a polypeptide sequence heterologous to SEQ ID NO:139.

45. (New) A composition comprising the isolated first polypeptide of claim 42 and an acceptable carrier.

46. (New) An isolated protein produced by the method comprising:
(a) expressing the first polypeptide of claim 42 by a cell; and
(b) recovering said protein.

47. (New) An isolated first polypeptide at least 90% identical to a second polypeptide consisting of amino acid residues 1 to 47 of SEQ ID NO:139, wherein said first polypeptide is capable of being used to generate or select an antibody that specifically binds the second polypeptide.

48. (New) The isolated first polypeptide of claim 47, wherein said first polypeptide is at least 95% identical to said second polypeptide.

49. (New) The isolated first polypeptide of claim 47 which comprises a heterologous polypeptide sequence.

50. (New) A composition comprising the isolated first polypeptide of claim 47 and an acceptable carrier.

51. (New) An isolated protein produced by the method comprising:
(a) expressing the isolated first polypeptide of claim 47 by a cell; and
(b) recovering said protein.

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52. (New) An isolated first polypeptide at least 90% identical to a second polypeptide consisting of the complete polypeptide encoded by the HBJFE12 cDNA contained in ATCC Deposit No. 209177, wherein said first polypeptide is capable of being used to generate or select an antibody that specifically binds the second polypeptide.

53. (New) The isolated first polypeptide of claim 52, wherein said first polypeptide is at least 95% identical to said second polypeptide.

54. (New) The isolated first polypeptide of claim 52 which further comprises a polypeptide sequence heterologous to SEQ ID NO:139.

55. (New) A composition comprising the isolated first polypeptide of claim 52 and an acceptable carrier.

56. (New) An isolated protein produced by the method comprising:
(a) expressing the isolated first polypeptide of claim 52 by a cell; and
(b) recovering said protein.

57. (New) An isolated polypeptide consisting of at least 30 contiguous amino acid residues of amino acid residues 19 to 47 of SEQ ID NO:139, wherein said isolated polypeptide is capable of being used to generate or select an antibody that specifically binds amino acid residues 19 to 47 of SEQ ID NO:139.

58. (New) The isolated polypeptide of claim 57 which consists of at least 50 contiguous amino acid residues of amino acid residues 19 to 47 of SEQ ID NO:139.

59. (New) The isolated polypeptide of claim 57 which further comprises a polypeptide sequence heterologous to SEQ ID NO:139.

60. (New) A composition comprising the isolated polypeptide of claim 57 and an acceptable carrier.

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61. (New) An isolated protein produced by the method comprising:

- (a) expressing the polypeptide of claim 57 by a cell; and
- (b) recovering said protein.

62. (New) An isolated protein consisting of at least 30 contiguous amino acid residues of the secreted portion of the polypeptide encoded by the HBJFE12 cDNA contained in ATCC Deposit No. 209177, wherein said isolated protein is capable of being used to generate or select an antibody that specifically binds the polypeptide encoded by the HBJFE12 cDNA contained in ATCC Deposit No. 209177.

63. (New) The isolated protein of claim 62 which consists of at least 50 contiguous amino acid residues of the secreted portion of the polypeptide encoded by the HBJFE12 cDNA contained in ATCC Deposit No. 209177.

64. (New) The isolated protein of claim 62 which further comprises a polypeptide sequence heterologous to SEQ ID NO:139.

65. (New) A composition comprising the isolated protein of claim 62 and an acceptable carrier.

66. (New) An isolated protein produced by the method comprising:

- (a) expressing the protein of claim 62 by a cell; and
- (b) recovering said protein.

67. (New) An isolated protein consisting of at least 30 contiguous amino acid residues of amino acid residues 1 to 47 of SEQ ID NO:139, wherein said isolated protein is capable of being used to generate or select an antibody that specifically binds amino acid residues 1 to 47 of SEQ ID NO:139.

68. (New) The isolated protein of claim 67 which consists of at least 50 contiguous amino acid residues of amino acid residues 1 to 47 of SEQ ID NO:139.

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69. (New) The isolated protein of claim 67 which further comprises a polypeptide sequence heterologous to SEQ ID NO:139.

70. (New) A composition comprising the isolated protein of claim 67 and an acceptable carrier.

71. (New) An isolated protein produced by the method comprising:

- (a) expressing the protein of claim 67 by a cell; and
- (b) recovering said protein.

72. (New) An isolated protein consisting of at least 30 contiguous amino acid residues of the complete polypeptide encoded by the HBJFE12 cDNA contained in ATCC Deposit No. 209177, wherein said isolated protein is capable of being used to generate or select an antibody that specifically binds the complete polypeptide encoded by the HBJFE12 cDNA contained in ATCC Deposit No. 209177.

73. (New) The isolated protein of claim 72 which consists of at least 50 contiguous amino acid residues of the complete polypeptide encoded by the HBJFE12 cDNA contained in ATCC Deposit No. 209177.

74. (New) The isolated protein of claim 72 which further comprises a polypeptide sequence heterologous to SEQ ID NO:139.

75. (New) A composition comprising the isolated protein of claim 72 and an acceptable carrier.

76. (New) An isolated protein produced by the method comprising:

- (a) expressing the protein of claim 72 by a cell; and
- (c) recovering said protein.

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77. (New) A method for preventing, treating, or ameliorating a medical condition, comprising administering to a mammalian subject a therapeutically effective amount of the isolated polypeptide of claim 11.

Remarks

Upon entry of the amendment, claims 1, 11, 13, 17-20, 22-24 and new claims 25-77 will be pending. Claims 2-10, 12, 14-16, and 21 have been canceled without prejudice or disclaimer. Applicants reserve the right to pursue the subject matter of all canceled claims in one or more divisional or continuation applications.

The title has been amended to more explicitly define the currently claimed invention. New claims 25-77 have been added to expand the embodiments of the elected subject matter. Support for the newly added claims is found throughout the specification as filed. Specifically, support for new claims 25-77 may be found at, for example, in Table 1 at page 162, row 33 (e.g. HBJFE12 ATCC Deposit, HBJFE12 amino acids 1-47, HBJFE12 amino acids 19-47); page 171, lines 19-28, pages 172, line 36 to page 174, line 8 (signal sequence/secreted portion); pages 175, line 32 to page 180, line 10 (90% and 95% identity); pages 180, line 12 to page 181, line 31 (30 and 50 contiguous amino acids); page 181, line 33 to page 182, line 31 (antibodies); page 182, line 33 to page 184, line 13; page 218, line 15 to page 219, line 24 (Example 9) (heterologous proteins); page 185, line 34 to page 186, line 4 (minus methionine); page 240-242 (Example 23) (example carriers); and, pages 210-218 (Examples 5-8) (polypeptide production).

Applicants note that the claimed invention, Gene No. 33, is expressed primarily in B-cell lymphoma. *See e.g.*, Specification, page 59, line 35. It is specifically known in the art that markers for B-cell lymphoma are useful in applications such as diagnosis and targeting of B-cell lymphomas, *inter alia*. *See e.g.*, Specification, page 59, line 36 to page 61, line 8.

Provisional Election With Traverse

The presently pending Office Action has restricted claims 1-24 into one of ten different groups, under 35 U.S.C. § 121, as allegedly encompassing inventions “distinct, each from the other...” *See*, Paper No. 8, page 2-3. In order to be fully responsive, Applicants hereby provisionally elect, with traverse, the subject matter of Group II (drawn to proteins as encompassed by claims 11, 12, and 16). Additionally, the pending Office Action has further required election of a single nucleic acid or amino acid sequence. *See*, Paper No. 8, page 8, last paragraph to page 9, second paragraph. Accordingly, Applicants

herein provisionally elect, with traverse, claims encompassing amino acid sequences corresponding to cDNA clone HBJFE12 encoded polypeptides (i.e. corresponding to Gene No. 33). Applicants also herewith submit an amendment adding new claims 25-77, drawn to the subject matter encompassed by Group II and to HBJFE12 encoded polypeptides. Applicants reserve the right to file one or more divisional applications directed to non-elected subject matter should the restriction requirement be made final. In such case, Applicants retain the right to petition from the restriction requirement under 37 C.F.R. § 1.144.

Applicants respectfully traverse and request the withdrawal of the Restriction Requirement. Applicants note that the MPEP indicates, "If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." MPEP § 803. Assuming *arguendo*, that the groups listed represent distinct or independent inventions, restriction remains improper unless it can be shown that the search and examination of each group would entail a "serious burden." M.P.E.P. § 803. In the present situation, no such showing has been made. Moreover, Applicants submit that a search of the nucleic acid sequences of Group I would provide useful information for the polypeptide sequences of Group II, which in turn, would provide useful information for the antibodies of Group III. Furthermore, the above said information would also provide useful information pertinent to examination of the claims encompassed by Groups IV-X. Hence, Applicants respectfully submit that a search encompassing the subject matter of Groups I-X would not impose a serious burden. Accordingly, Applicants respectfully request the restriction requirement be withdrawn.

Conclusion

If there are any fees due in connection with the filing of this paper, please charge the fees to our Deposit Account No. 08-3425. If a fee is required for an extension of time under

37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Dated: July 26, 2002

Respectfully submitted,

By 

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